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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,389	12/10/2001	Jean-Noel Thorel	108961.01	8418
7590	12/12/2005		EXAMINER	
OLIFF & BERRIDGE, PLC P.O. Box 19928 Alexandria, VA 22320			COE, SUSAN D	
			ART UNIT	PAPER NUMBER
			1655	
DATE MAILED: 12/12/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/006,389	THOREL, JEAN-NOEL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Susan D. Coe	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2005 and 26 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-13,16,18-23 and 29-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-13,16,18-23 and 29-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 29, 2005 has been entered.
2. Claim 14 has been cancelled.
3. Claims 1-3, 5-13, 16, 18-23, and 29-35 are currently pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-3, 5-13, 16, 18-23, and 29-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a "written description" rejection, rather than an enablement rejection under 35 U.S.C. 112, first paragraph. Applicant is directed to the Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, 1 "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001.

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The claims are drawn to a cosmetic comprising a biodermal fraction composed of elements naturally found in skin. However, the specification only discloses about 40 different natural skin ingredients that can be used to successfully formulate the cosmetic (see page 10-12). In analyzing whether the written description requirement is met for genus claims, it is first determine whether a representative number of species have been sufficiently described. In this case, only 40 skin ingredients have been described while there are thousands of different chemicals that can be found in the skin. Applicant has only demonstrated cosmetics can be successfully formulated using a specific combination of these 40 main ingredients (see page 13-17). This limited information is not deemed sufficient to reasonably convey to one skill in the art that applicant was in possession of cosmetics comprising all of the ingredients naturally found in the skin at the time the application was filed. Thus, it is concluded that the written description requirement is not satisfied for the claimed genus.

5. Claims 1-3, 5-13, 16, 18-23, and 29-35 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for using the ingredients described in page 10-17 of the specification to create cosmetics, does not reasonably provide enablement for using all possible elements found in the skin to formulate a cosmetic. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Undue experimentation would be required to practice the invention as claimed due to the quantity of experimentation necessary; limited amount of guidance and limited number of working examples in the specification; nature of the invention; state of the prior art; relative

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skill level of those in the art; predictability or unpredictability in the art; and breadth of the claims. In re Wands, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

Applicant's claims broadly claim cosmetics that comprise at least two ingredients naturally found in the skin. Applicant's claims exclude excipients or vehicles and most other non-skin ingredients commonly used in cosmetics. However, applicant's claims only describe a limited number of embodiments and combinations that successfully form a cosmetic composition. It is well known in the art that the formulation of a successful cosmetic is very complex. Numerous factors such as texture, viscosity, skin-feel, stability, fragrance, and color have to be taken in account in addition to the overall functionality of the cosmetic. By excluding the ingredients that are commonly used to achieve a successful cosmetic, applicant's specification must demonstrate how a cosmetic can be successfully formulated. Applicant's specification does give examples of cosmetics that are encompassed by the claims. However, the claims are of a broad nature that encompass numerous ingredients that are not described in the specification. Thus, a person of ordinary skill in the art would be forced to experiment unduly to determine how to formulate all of the potential cosmetics that fall within the breadth of applicant's claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1-3, 5-8, 12, 16, 18-23, 29-35 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,382,431.

US '431 teaches a composition for topical application to the skin. The active ingredient is a digest of collagen and/or elastin in combination with minerals such as copper and zinc (see column 5, lines 36-end). The active ingredient can be added to a compound such as stearic acid or squalene (see column 6, lines 59-end). All of these ingredients are found in the skin; thus, the reference is deemed to anticipate the claimed invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5-13, 16, 18-23, and 29-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 63-141908 in view of US Pat. No. 5,547,677 and US Pat. No. 5,310,556.

JP '908 teaches a O/W or W/O emulsion. The composition contains between 0.2 to 5.0% of ceramide, 0.05 to 2.0% of carboxyvinyl polymer (non-biodermal), 2.0 to 7.0% of a surfactant, and 10 to 70% of an oily substance (see English abstract). The reference does not specify the identity of the surfactant or the oily substance. US '677 teaches that squalene is known to be used in the oil phase of an oil-in-water emulsion (see claim 4). Thus, a person of ordinary skill in the art would reasonably expect that squalene could be used as the oily substance in JP '908. In addition, US '556 teaches using both lecithin and cholesterol to form emulsions (see bottom of

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column 5). Therefore, a person of ordinary skill in the art would reasonably expect that lecithin and cholesterol could also be used in the surfactant and oily portions of the cosmetic of JP '908. Based on these reasonable expectations of success, a person of ordinary skill in the art would be motivated to use squalene, cholesterol, and lecithin in the composition taught by JP '908. Thus, the combination of these three references is considered to teach applicant's claimed invention.

8. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday to Thursday from 9:30 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey, can be reached at (571) 272-0775. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding can be directed to the receptionist whose telephone number is (571) 272-1600.



12-5-05

Susan D. Coe  
Primary Examiner  
Art Unit 1655